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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,963	02/27/2004	Radha Sen	200312102-1	9177

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EXAMINER

YOON, TAE H

ART UNIT PAPER NUMBER

1714

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,963

Applicant(s)

SEN ET AL.

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 26, 48, 49 and 51-705 is/are pending in the application.
- 4a) Of the above claim(s) 26-45 and 59-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48, 49 and 51-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Note new examiner because the case has been transferred to me.

Applicant's election of Group II, claims 48 and 52-58, in the reply filed on June 26, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant has requested examination of claims 49-51 as well and thus claims 48, 49 and 51-58 are examined. Note that claim 50 has been cancelled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 58 contains the trademark/trade name Rhodiasove DIB, TEXANOL, SER-AD FX-510 and SER-AD FX-511. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe goods and, accordingly, the identification/description is indefinite.

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Also, the recited "ester of ethylene glycol, propylene glycol, hexylene glycol, 2-butoxyethanol" is confusing since it is unclear. Does ester limit ethylene glycol only or other species?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48, 49 and 51-56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al (US 2002/0155260 A1).

Chen et al teach the instant core-shell latex and a coating composition thereof in [0032] and [0035] wherein the interconnected pore of coated film is taught. Said core-shell latex is same as in the invention and thus it would exhibit self-adhesive properties at room temperature inherently.

Thus, the invention lacks novelty.

Claims 48, 49 and 51-57 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al (US 6,375,320).

Chen et al) teach the instant core-shell latex and a coating composition thereof at col. 4, line 7 to col. 6, line 16. Said coating inherently would form microporous layer. Said core-shell latex is same as in the invention and thus it would exhibit self-adhesive properties at room temperature inherently. Chen et al also teach employing polyhydric alcohols at col. 5, line 10, and said polyhydric alcohols meet the instant coalescing agents.

Thus, the invention lacks novelty.

Claims 48, 49 and 51-58 are rejected under 35 U.S.C. 103(a) as obvious over Chen et al (US 6,375,320) or Chen et al (US 2002/0155260 A1) in view of Lehman et al (US 6,872,278), Atherton et al (US 5,242,888), Keeler (US 4,172,064) or Gebhard et al (US 2005/0009954 A1).

The invention invention further recites particular coalescing agents over Chen et al (US'320) who teach employing polyhydric alcohols and other additives such as rheology modifiers at col. 4, lines 44-45. Chen et al (US'260) also teach employing other additives such as rheology modifiers in [0037].

Lehman et al teach the instant coalescing agents at col. 8, line 57 to col. 9, lines 8, and coalescing agents are well known rheology modifiers yielding faster film

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formation of coating compositions. Atherton et al (col. 7, lines 19-25), Keeler (col. 4, lines 43-62) and Gebhard et al ([0119]) teach the instant coalescing agents.

It would have been obvious to one skilled in the art at the time of invention to utilize art well known coalescing agents of Lehman et al, Atherton et al, Keeler or Gebhard et al in Chen et al (US'320 or US'260) since Chen et al teach employing other additives such as rheology modifiers and since coalescing agents are well known rheology modifiers yielding faster film formation of coating compositions, and since Chen et al (US'320) teach employing polyhydric alcohols encompassing ethylene glycol, for example.

Claims 48, 49, 51-54 and 57 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Upson et al (US 4,497,917).

Upson et al teach a core-shell latex composition in abstract and example 2. Core has a T_g greater than of 70°C, and shell has a T_g of 25 to 60°C.

Thus, the invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
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THY/August 5, 2005